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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/179,405	10/27/1998	KI-YOUNG KIM	1293:1050/MD	5634

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EXAMINER

DEANE JR, WILLIAM J

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 05/05/2004

29

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/179,405

Applicant(s)

KIM ET AL.

Examiner

William J Deane

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 28.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

Claims 20 – 21 are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 6,091,808 (Wood et al.) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wood et al. in view of U.S. Patent No. 5,764,736 (Shachar et al.).

With respect to claims 20 and 21, Wood et al teach a number searching system comprising: a phone (10); a telephone number database (42); a web server (34); an information terminal 12 (see Col. 3, lines 49 - 55) which displays a search for telephone number (see Fig. 3, element 68) and a telephone plug-in which automatically dials the displayed number (Compare page 6, lines 6 - 13 of the present application with Col. 6, line 56 - Col. 7, line 5 of Wood et al.). Note the telephone is connected to a second telephone line 14 of Fig 1. Note that the plug-in is near the web browser. With respect to the connection of the plug-in to a web browser, second telephone line and the telephone see Fig 1.

The examiner notes Wood et al teach (col. 6, line 56 - col.7, line 9) that:  
"On clicking the DIAL button 75 [Fig. 3], the web page manager 36 communicates a message, containing ... a called telephone number DN from the windows 68 [Fig. 3]... to the call control interface 46, via which this message is forwarded.... to the telephone switch 16. The switch 16 checks validity of the telephone numbers and that the subscriber's telephone 10 (calling telephone number CN) is on-hook, and provides a (possibly distinctive) ringing signal to the telephone 10. The subscriber, expecting this ring signal, takes his telephone 10 off-hook, and

this is detected by the telephone switch 16 in conventional manner, in response to which the switch 16 sets up the desired telephone connection to the called number DN in the same manner as if the number DN had been dialed by the subscriber at the telephone 10." [Emphasis added]. When the subscriber at the telephone 10 dials a called directory number DN, the telephone switch 16 connects the call to the dialed DN independent of the web facility 22/web server 34 ("normal telephone call").

On one hand, clicking the dial button 75, as described above, may be read as the claimed "plug-in" having the ability to set-up the communication channel. In addition, note the definition of "plug-in" as defined by Harry Newton, Newton's Telecom Dictionary, March 1998, Flatiron Publishing, 14<sup>th</sup>, page 555. Therefore the button 75 performs the function of the plug-in as defined by Newton.

On the other hand, since the Wood et al reference does not specifically use the exact term "plug-in" or describe the plug-in (as it is inherent as shown above), the Examiner provided the Shachar reference which explicitly teaches the use of a "plug-in" to set-up a communication channel (Shachar, col. 5, line 60 - col. 6, line 27). The communication channel in Wood et al is set-up using "a personal computer executing browsing software" (Wood et al, Col. 3, lines 58-64). Thus, it would have been more than obvious to use a "plug-in" function as taught by Shachar in the personal computer of Wood et al. Plug-in's are software components that extend the capabilities of a web browser to perform different functions such as setting-up a communication channel. The "plug-in" taught by Shachar would provide the Wood et al user with a convenient way to

set-up the communication channel. Hundreds of plug-ins (software components) have been available for sale for many years.

### ***Response to Arguments***

The issue in this case is whether the Wood et al device has a plug-in, "connected" with said phone and said information terminal (web browser 12 in Wood et al., i.e., a computer) which can automatically dial a telephone number to set up a communication channel through a telephone 10 independent of a web server (web facility 22 in Wood et al.). Note that the elements in Fig. 2, particularly web server 34 are contained in web facility 22, see Col. 4, lines 49 - 52, therefore web facility 22 is the claimed "web server" and the "information terminal" web browser 12 in Wood et al.

Applicants seem to argue two things with respect to the plug-in. First is, that the plug-in in Wood et al. does not set up a communication channel through a telephone independent of a web server and the information terminal. Second, that there is no plug-in contained in the information terminal of the Wood et al. reference. Applicants were asked to compare page 6, lines 6 – 13 of the present application and Col. 6, line 56 – Col. 7, line 5 of Wood et al. There is no question that plug-in software exists in the Wood et al. reference and that the plug-in software is contained in the information terminal. Again, please note the definition of "plug-in as recited in Newton's Telecom Dictionary. There is no difference between the present application and the Wood et al. reference with respect to a plug-in in which an automatic dialing operation carries out a program, which once the telephone number is displayed on web browser 12, the computer can dial the telephone number automatically after being selected. Even if

applicant could argue that the plug-in is not part of the information terminal, note Shachar et al.

With respect to the issue of whether Wood et al. can set up a communication channel through a telephone 10 independent of a web server 22 and an "information terminal", such is taught by Wood et al. One looking at Fig. 1 should understand that a communication channel through a telephone 10 independent of a web server 22 and an "information terminal" 12 is how the Wood et al. device operates. Wood et al. teach that a path 14 is a twisted pair (telephone line), path 18 is any suitable data communication path (separate from path 14, Col. 3, lines 46 – 49), and path 24, which connects web facility 22 to telephone switch 16, is X.25 or Ethernet path. When the subscriber uses telephone 10 and path 14 to make a phone call, this does not require, and operates independently from, web browser 12 and web facility 22. A normal phone call does not require the use of data path 18 or the X.25/Ethernet path 24. Wood et al. teach that after clicking on the DIAL button, web facility 22 sends a message to telephone switch 16 and then the switch sets up a call "in the same manner as if the number ... had been dialed by the subscriber at telephone 10." Again, there is absolutely no need to use web browser 12, data path 18, or X.25/Ethernet path 24 to set up the phone call. Thus, the phone call, in Wood et al., is set up independent of the web server and the web browser/"information terminal.

With respect to the idea of the web browser and plug-in being located near one another, whether they are located or are not located near one another would be of no

patentable weight. In addition, support for such language was not found in the specification nor did applicant point to where such language could be found.

With respect to the connection of the plug-in to a web browser, second telephone line and the telephone see Fig 1.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (703) 306-5838. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (703) 872-9306.

28Apr04

  
**WILLIAM J. DEANE, JR.**  
**PRIMARY EXAMINER**